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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,461	06/22/2006	Yuichi Ito	1000023-000111	3314
21839 7590 02/04/2009 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER MCCLENDON, SANZA L				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 02/04/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/584,461

Applicant(s)

ITO ET AL.

Examiner

Sanza L. McClendon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2009 has been entered.

Response to Amendment

2. The proposed Declaration filed on 1/26/2009 has not been entered because it is unsigned.

Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME LIMIT MAY BE GRANTED UNDER 37 CFR 1.136(a).

Response to Arguments

3. Applicant's arguments filed 1/26/2009 have been fully considered but they are not persuasive. Applicant appears to be relying on the amendment to the claims that incorporates the general formula of component (B). Applicant additionally argues that the Niwa references fails to disclose a component having the same formula as found in the claims pointing the examiner to the examples where Niwa et al teaches using sulfonium salts. This is not persuasive because per section [0054] Niwa et al teaches an iodonium salt photoinitiator with sufficient specificity (formula 25) that is encompassed by the claimed formula when at least one R group is a tert-butyl and the

others are hydrogen. Thus Niwa et al is deemed to read on applicant claimed invention.

4. Applicant additionally refers to the Declaration filed April 14, 2008 regarding the unexpected results when the claimed components in the specified ratios. This is not sufficient to overcome the rejections of Niwa et al because Niwa et al teaches the same components in the same specified ratios, as well as, teaching with at least 5% by weight of a vinyl ether (corresponding to applicant's component (C)) the composition has improved curability. And as set forth before in earlier rejections one of ordinary skill in that art would have expected good transparency when using the vinyl ether in the lower claimed ranges for the same reasons—see Final Office action and Advisory Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al (JP 08-269392).

Niwa et al sets forth a composition comprising an oxetane compound and a cationic photoinitiator that can additionally comprise from 5 to 95 parts by weight of a vinyl ether compound. Niwa et al teaches the cure rates is improved by the addition of vinyl ether to the oxetane composition—see [0065]. The cationic photoinitiator can be an onium salt of the type described in sections [0053] to [0059], wherein formula 25 reads on applicant's formula found in the claims. Said composition is useful in coating optical fibers, which can be colored (i.e., ink or paint) and is adhesive. It is deemed that the applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al and thus anticipated. It is also deemed that one of ordinary

skill in that art would have expected good light transmittance in the cured product comprising the mixture of an oxetane and vinyl ether because it is known in the optical fiber art that yellowing of the cured coating caused problems in attenuation. Thus, the invention is anticipated by the reference.

7. Claims 1-6, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al (JP 08-231938).

Niwa et al sets forth a composition comprising an oxetane compound and a cationic photoinitiator that can additionally comprise from 5 to 95 parts by weight of a vinyl ether compound. Niwa et al teaches the cure rates is improved by the addition of vinyl ether to the oxetane composition—see [0065]. The cationic photoinitiator can be an onium salt of the type described in sections [0053] to [0059], wherein formula 25 reads on applicant's formula found in the claims. Said composition is useful as a laminate adhesive. It is deemed that the applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al and thus anticipated. Per examples, it is taught that the compositions have good appearance—see [0077] and Table 2, 3rd column for example 3. Thus, the invention is anticipated by the reference.

8. Claims 1-4, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al (JP08-218296).

Niwa et al sets forth a composition comprising an oxetane compound and a cationic photoinitiator that can additionally comprise from 5 to 95 parts by weight of a vinyl ether compound. Niwa et al teaches the cure rates is improved by the addition of vinyl ether to the oxetane composition—see [0065]. The cationic photoinitiator can be an onium salt of the type described in sections [0053] to [0059], wherein formula 25 reads on applicant's formula found in the claims. Said composition is useful for coating paper and other substrates. Said coating composition is taught to have high gloss. It is deemed that the applicant's 0.01 to 10% by weight of component (C) is encompassed in the range taught by Niwa et al and thus anticipated. Per examples, it is taught that the compositions have good gloss—see [0079] and Table 2, 3rd column for example 3. Thus, the invention is anticipated by the reference.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/
Primary Examiner, Art Unit 1796

SMc